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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,964	02/02/2001	Kiyozo Asada	1333-DIV2-00	9656

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EXAMINER

PARKIN, JEFFREY S 16

ART UNIT PAPER NUMBER

1648

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,964

Applicant(s)

ASADA ET AL.

Examiner

Jeffrey S. Parkin, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 90-97 is/are pending in the application.
- 4a) Of the above claim(s) 1,90-94,96 and 97 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/809,156.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Detailed Office Action

Status of the Claims

1. Applicants' election of Group IV (claim 95) in paper no. 15 is acknowledged. Because applicant did not distinctly and specifically point out the purported errors in the restriction requirement, the election has been treated as an election without
5 traverse (refer to M.P.E.P. § 818.03(a)). Claims 1 and 90-94 are withdrawn from further consideration by the examiner, pursuant to 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention

2. Newly submitted claims 96 and 97 are directed to an invention
10 that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed toward nucleic acids and probes and are structurally and functionally independent and distinct from the elected polypeptide. Since applicant has received an action on the merits for the originally
15 presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 96 and 97 are withdrawn from further consideration as being directed towards a nonelected invention (refer to 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03).

35 U.S.C. § 112, Second Paragraph

3. Claim 95 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the
25 invention. The claim specifies a polypeptide sequence "represented" by SEQ ID NO.: 5 which is vague and indefinite since the precise structure of the polypeptide is not clearly set forth. For instance, is the claim directed toward a polypeptide consisting of SEQ ID NO.: 5 or a polypeptide comprising SEQ ID NO.: 5? Does

the term "represented" by allow for additional amino acid additions, deletions, or substitutions? Appropriate correction is required (i.e., An isolated and purified polypeptide consisting of SEQ ID NO.: 5).

5

35 U.S.C. § 112, First Paragraph

4. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

10 The specification shall contain a written description of the
invention, and of the manner and process of making and using it, in
such full, clear, concise, and exact terms as to enable any person
skilled in the art to which it pertains, or with which it is most
nearly connected, to make and use the same and shall set forth the
15 best mode contemplated by the inventor of carrying out his
invention.

5. Claim 95 is rejected under 35 U.S.C. § 112, first paragraph, as
containing subject matter which was not described in the
specification in such a way as to reasonably convey to one skilled
20 in the relevant art that the inventor(s), at the time the
application was filed, had possession of the claimed invention. *In*
re Rasmussen, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In*
re Wertheim, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). The
claim is directed toward "functional equivalents" of a human
25 fibronectin fragment. The fragment is 457 amino acids in length.
The disclosure does not describe any other variants of this
sequence with the desired properties.

To satisfy the written description requirement, a patent
specification must describe the claimed invention in sufficient
30 detail that one skilled in the art can reasonably conclude that the
inventor had possession of the claimed invention. See, e.g., *Vas-*
Cath, Inc., v. Mahurkar, 935 F.2d at 1563, 19 U.S.P.Q.2d at 1116.
The issue raised in this application is whether the original
application provides adequate support for the broadly claimed genus
35 of human fibronectin functional equivalents. Functionally

equivalent polypeptides may contain single or multiple amino acid additions, substitutions, or deletions. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2d 1961, 1966 (Fed. Cir. 1997). The claimed invention as a whole may not be adequately described where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A biomolecule sequence described only by functional characteristic, without any known or disclosed correlation between that function and the structure of the sequence, normally is not a sufficient identifying characteristic for written description purposes, even when accompanied by a method of obtaining the biomolecule of interest. *In re Bell*, 991 F.2d 781, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993). *In re Deuel*, 51 F.3d 1552, 34 U.S.P.Q.2d 1210 (Fed. Cir. 1995). A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 U.S.P.Q.2d 1895, 1905 (Fed. Cir. 1995). The court noted in this decision that a "laundry list" disclosure of every possible moiety does not constitute a written description of every species in a genus because it would not reasonably lead those skilled in the art to any particular species.

An applicant may show possession of an invention by disclosure of drawings or structural chemical formulas that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. An applicant may also show that an invention

is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics. For some biomolecules, examples of identifying characteristics include a nucleotide or amino acid sequence, chemical structure, binding affinity, binding specificity, and molecular weight. The written description requirement may be satisfied through disclosure of function and minimal structure when there is a well-established correlation between structure and function. Without such a correlation, the capability to recognize or understand the structure from the mere recitation of function and minimal structure is highly unlikely. In the latter case, disclosure of function alone is little more than a wish for possession; it does not satisfy the written description requirement. *Regents of the University of California v. Eli Lilly*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2d 1398, 1404, 1406 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998). *In re Wilder*, 736 F.2d 1516, 1521, 222 U.S.P.Q. 369, 372-3 (Fed. Cir. 1984). Factors to be considered in determining whether there is sufficient evidence of possession include the level of skill and knowledge in the art, partial structure, physical and/or chemical properties, functional characteristics alone or coupled with a known or disclosed correlation between structure and function, and the method of making the claimed invention.

As set forth *supra*, the claimed invention encompasses single or multiple amino acid additions, deletions, or substitutions. However, the disclosure fails to describe the molecular determinants modulating the functional properties of the claimed polypeptide. Thus, it is not readily manifest to the skilled

artisan which peptidic variants will have the desired activity. The disclosure also fails to provide any human fibronectin fragment variants that will retain the desired activity. Thus, there is nothing in the disclosure that would lead the skilled artisan to any particular amino acid sequence. Since the skilled artisan cannot predict or envision the structure of any of these polypeptide variants, the inventors clearly did not have possession of the claimed invention at the time of filing.

35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 95 is rejected under 35 U.S.C. § 102(b) as being anticipated by Hashi et al. (1994). Hashi and colleagues disclose a fibronectin fragment that is identical with the first 432 amino acids of the claimed sequence (see Appendix A). Thus, the skilled artisan would reasonably expect this polypeptide fragment to retain the same functional properties as the parent polypeptide, absent evidence to the contrary.

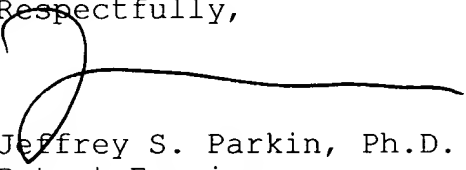
Correspondence

8. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the

Examiner prior to the submission of such documents to facilitate their expeditious processing and entry.

- 5 9. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be
10 reached at (703) 308-4027 or (703) 308-1122, respectively. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,



Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

17 March, 2003

Appendix A: Nucleotide sequence comparison between SEQ ID NO.: 8
from U.S. Patent No. 5,302,701 and claimed polypeptide SEQ ID NO.:
5.

Query Match 94.1%; Score 2257; DB 1; Length 432;
Best Local Similarity 99.8%; Pred. No. 2.9e-161;
Matches 431; Conservative 0; Mismatches 1; Indels 0; Gaps 0;

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Qy      1 PTDLRFTNIGPDTMRVTWAPPPSIDLTNFLVRYSPVKNEEDVAELSISPSDNAVVLTNLL 60
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db      1 PTDLRFTNIGPDTMRVTWAPPPSIDLTNFLVRYSPVKNEEDVAELSISPSDNAVVLTNLL 60

Qy     61 PGTEYVVS SVSSVYEQHESTPLRGRQKTGLDSPTGIDFSDITANSFTVHWIAPRATITGYR 120
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db     61 PGTEYVVS SVSSVYEQHESTPLRGRQKTGLDSPTGIDFSDITANSFTVHWIAPRATITGYR 120

Qy    121 IRHHPEHFSGRPREDRVPHSRNSITLTNLTPGTEYVVSIVALNGREESPLLIGQQSTVSD 180
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db    121 IRHHPEHFSGRPREDRVPHSRNSITLTNLTPGTEYVVSIVALNGREESPLLIGQQSTVSD 180

Qy    181 VPRDLEVVAATPTSL LISWDAPAVTVRYRITYGETGGNSPVQEFTVPGSKSTATISGLK 240
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db    181 VPRDLEVVAATPTSL LISWDAPAVTVRYRITYGETGGNSPVQEFTVPGSKSTATISGLK 240

Qy    241 PGVDYTITVYAVTGRGDS PASSKPI SINYTEIDKPSMAAGSITTLPALPEDGGSGAFPP 300
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db    241 PGVDYTITVYAVTGRGDS PASSKPI SINYTEIDKPSMAAGSITTLPALPEDGGSGAFPP 300

Qy    301 GHFKDPKRLYCKNGGFFLR IHPDGRVDGVREKSDPHIKLQLQAEERG VVSIKGV CANRYL 360
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db    301 GHFKDPKRLYCKNGGFFLR IHPDGRVDGVREKSDPHIKLQLQAEERG VVSIKGV CANRYL 360

Qy    361 AMKEDGRLLASKCVTDECFFFERLESNNYNTYRSRKYTSWYVALKRTGQYKLGSKTGPGQ 420
        | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | | |
Db    361 AMKEDGRLLASKCVTDECFFFERLESNNYNTYRSRKYTSWYVALKRTGQYKLGSKTGPGQ 420

Qy    421 KAILFLPMSAAS 432
        | | | | | | | | |
Db    421 KAILFLPMSAKS 432
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